1652

PATENT
Customer No. 22,852
Attorney Docket No. 08702.0001-03000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#10
MQJ
5/5/03

In re Application of:

BOODHOO et al.

Application No.: 09/996,620

Filed: November 27, 2001

For: HIGHLY PURIFIED MOCARHAGIN, A COBRA VENOM PROTEASE, POLYNUCLEOTIDES ENCODING SAME AND RELATED PROTEASES, AND THERAPEUTIC USES THEREOF

Group Art Unit: 1652

Examiner: Rebecca Prouty

Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated March 25, 2003, the Examiner required restriction under 35 U.S.C. § 121 between Group I (claims 1-7, 11, 12, 16-21, 27-31, 37-41, 47-51, 57-61, 67-71, 77-81, and 87-89) drawn to mocarhagin proteins and compositions thereof, Group II (claims 8, 9, 13, 14, and 96-99) drawn to methods of treating inflammatory diseases, Group III (claim 10) drawn to methods of isolating mocarhagin, and Group IV (claim 15) drawn to mocarhagin antibodies.

The restriction requirement is respectfully traversed. However, to be fully responsive to the restriction requirement, Applicants elect, with traverse, the subject

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

matter of Group I, claims 1-7, 11, 12, 16-21, 27-31, 37-41, 47-51, 57-61, 67-71, 77-81, and 87-89.

In the Office Action, the Examiner failed to indicate the reason why the joint examination of claims from Groups I, II, III, and IV would be a serious burden, other than to mention that the inventions are distinct. The Examiner's attention is respectfully directed to M.P.E.P. § 803, which sets forth criteria and guidelines for the Examiner to follow in making a proper requirement for restriction. The M.P.E.P. instructs the Office as follows:

> If the search and examination of an entire application can be made without **serious** burden, the Office must examine it on the merits, **even though it includes claims to distinct or independent inventions**.

M.P.E.P. § 803 (emphasis added).

Applicants traverse the restriction requirement on the grounds that the Examiner has not shown that there would be a **serious** burden to examine Groups I, II, III, and IV together, despite the statement that a prior art search of these groups includes different areas of classification. In fact groups I and II do not even include different areas of classification. Both groups are classified in class 424, subclass 94.67. The claims all relate to one specific protein, antibodies against the protein, and methods of using the protein to treat inflammatory disease. All these classes could be examined with a single search because any reference describing treatments with mocarhagin, antibodies to mocarhagin, and methods of isolating mocarhagin would also describe the protein itself.

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In view of the foregoing remarks, Applicants submit that the Examiner has not established a *prima facie* case of serious burden of search. Accordingly, Applicants respectfully request that the restriction requirement be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 25, 2003

By: E Stewart Mittler

E. Stewart Mittler
Reg. No. 50,316

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com